



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/589,217

06/07/2000

David Cooper

13665

8681

23389

7590

01/03/2013

SCULLY SCOTT MURPHY & PRESSER, PC

400 GARDEN CITY PLAZA

SUITE 300

GARDEN CITY, NY 11530

EXAMINER

CASCA, FRED A

ART UNIT

PAPER NUMBER

2644

MAIL DATE

DELIVERY MODE

01/03/2013

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/589,217	<b>Applicant(s)</b> COOPER, DAVID	
	<b>Examiner</b> FRED CASCA	<b>Art Unit</b> 2644	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28,29 and 32-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28,29 and 32-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 10/07/2011 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 28, 29, 33-38 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618) in view of Falco (US 6493539).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 7, 101) for a mobile communication system (fig. 7 and col. 13, lines 21-37) comprising:

receiving a message on said user equipment including a first list including a plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to a plurality of available networks available for a potential handover ("The SIDs available for hand-off would be selected

Art Unit: 2644

and stored” see col. 12, lines 1-5, and Col. 8, lines 40-41, “Another example is found in hand-off situation,” note that the SID can be transmitted in handoff or potential handoff situations),

said receiving from a current active communication network while a call subject to a potential handover, is in progress (Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,” “complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel” see col. 16, lines 21-46); and

selecting one network of the plurality of available networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment (“The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off” see col. 12, lines 1-5),

wherein said current active communication network signals one or more of the plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network (“the current version number is broadcast over the FOCC” see col. 16, lines 21-46).

Lynch does not specifically disclose the pluralities of available networks are determined by the current active communication network by scanning an area for all available networks within the area.

Art Unit: 2644

In an analogous art, Falco discloses a plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area (fig. 3 and 6 and particularly col. 6, line 59 to col. 7, line 3 and col. 7, lines 19-52, " Upon receipt of the resulting signals, at step S220, the serving base station 10 determines which neighboring base stations are good candidates for a geo-location of the mobile 40. The neighboring base stations that received the transmit signals from the mobile 40 with a signal quality that is sufficiently high are assigned to be candidate base stations 20," note that the serving base station is equivalent to the "current active communication network," and the candidate neighboring base stations are equivalent to the "available networks." Further note that current base station determines the candidate base stations based on signals received from them and their TOA information, thus, the current base station must scan them as well).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Lynch by having the plurality of available networks to be determined by the current active communication network by scanning an area for all available networks within the area so that the available networks are selected an entity already involved in the communication in the area and thereby providing an efficient communication system.

Regarding claim 29, Lynch discloses User equipment (fig. 7, 101) for a mobile communication network (fig. 7 and col. 13, lines 21-37) comprising:

means for receiving a message that includes a first list including a plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5 and Col. 8, lines 40-41, “Another example is found in hand-off situation,” note that the SID can be transmitted in handoff or potential handoff situation), from a current active the communication network while a call, subject to a potential handover, is in progress (Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,” “complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel” see col. 16, lines 21-46); and

means for selecting one network of the plurality of available networks to which the user equipment hands over based on a comparing of said first list with a second list stored in the user equipment (“The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off” see col. 12, lines 1-5), wherein said current active communication network signals one or more of the plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network (“the current version number is broadcast over the FOCC” see col. 16, lines 21-46).

Lynch does not specifically disclose the plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area.

In an analogous art, Falco discloses a plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area (fig. 3 and 6 and particularly col. 6, line 59 to col. 7, line 3 and col. 7, lines 19-52, " Upon receipt of the resulting signals, at step S220, the serving base station 10 determines which neighboring base stations are good candidates for a geo-location of the mobile 40. The neighboring base stations that received the transmit signals from the mobile 40 with a signal quality that is sufficiently high are assigned to be candidate base stations 20," note that the serving base station is equivalent to the "current active communication network," and the candidate neighboring base stations are equivalent to the "available networks." Further note that current base station determines the candidate base stations based on signals received from them and their TOA information, thus, the current base station must scan them as well).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Lynch by having the plurality of available networks to be determined by the current active communication network by scanning an area for all available networks within the area so that the available networks are selected an entity already involved in the communication in the area and thereby providing an efficient communication system.

Regarding claim 33, Lynch discloses user equipment (fig. 7, 101) for a mobile communication network (fig. 7 and col. 13, lines 21-37) comprising:

a receiver for receiving a message that includes a first list of a plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), from a current active communication network while a call subject to potential handover is in progress (Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,”

“complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel” see col. 16, lines 21-46); and

a selector for selecting one network of the plurality of available networks to which the user equipment hands over based on a comparing of said first list with a second list stored in the user equipment (“The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off” see col. 12, lines 1-5) wherein said current active communication network signals one or more of the plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), and said receiver receives said message without said user



Art Unit: 2644

equipment searching any communication network ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Lynch does not specifically disclose the plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area.

In an analogous art, Falco discloses a plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area (fig. 3 and 6 and particularly col. 6, line 59 to col. 7, line 3 and col. 7, lines 19-52, " Upon receipt of the resulting signals, at step S220, the serving base station 10 determines which neighboring base stations are good candidates for a geo-location of the mobile 40. The neighboring base stations that received the transmit signals from the mobile 40 with a signal quality that is sufficiently high are assigned to be candidate base stations 20," note that the serving base station is equivalent to the "current active communication network," and the candidate neighboring base stations are equivalent to the "available networks." Further note that current base station determines the candidate base stations based on signals received from them and their TOA information, thus, the current base station must scan them as well).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Lynch by having the plurality of available networks to be determined by the current active communication network by scanning an area for all available networks within the area so that the available networks are selected an

Art Unit: 2644

entity already involved in the communication in the area and thereby providing an efficient communication system.

Regarding claim 34, the combination of Lynch/Falco discloses the method for user equipment for a mobile communication system according to claim 28, wherein said message is a dedicated message (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) for signaling available networks for handover (Lynch, “complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel” see col. 16, lines 21-46. Also see Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has begun,”).

Regarding claim 35, the combination of Lynch/Falco discloses the method for user equipment for a mobile communication system according to claim 34, wherein said message is periodically transmitted by said current active network without a specific request (see Col. 8, lines 19-22, “periodically thereafter”, and see Col. 17, lines 61-63, “download can take place periodically,” col. 16, lines 21-46 “the current version number is broadcast over the FOCC”).

Regarding claim 36, the combination of Lynch/Falco discloses the method for user equipment for a mobile communication system according to claim 28, further

Art Unit: 2644

comprising the step of: storing said first list in said user equipment ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46).

Regarding claim 37, the combination of Lynch/Falco discloses the method for user equipment for a mobile communication system according to claim 34, wherein said message includes a special identifier indicating that said message contains a list of available networks for handover ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 38, the combination of Lynch/Falco discloses the method for user equipment for a mobile communication system according to claim 36, further comprising the step of: receiving, by the user equipment, a second message including at least one network identifier corresponding to a network that is to be deleted from the first list ("set to "zero" for a deletion from the SID list stored in the mobile subscriber unit" see col. 16, lines 21-46).

Claim 49 is analogous to the features of claim 28, thus it is rejected for the same reasons set forth above.

4. Claim 32, 47, 48, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Daly (US 6,122,503; previously cited) in view of Falco (US 6,493,539) and further in view of I (US 6,088,335).

Regarding claim 32, Lynch discloses a mobile communications network or component (fig. 7 and col. 13, lines 21-37) thereof including:

means for receiving by a user equipment (fig. 7, 101) a message that includes a first list including a plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover (see Col. 12, lines 2-9, ‘SIDs available for hand-off,” Also see Col. 8, lines 40-41, “Another example is found in hand-off situation,” note that the SID can be transmitted in handoff or potential handoff situations. “The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), from a current active communication network while a call subject to potential handover is in progress (Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,” Col. 12, lines 2-9, “SIDs available for hand-off,” Also see col. 16, lines 21-46 “complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel”);

means for selecting one network of a plurality of networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment (“The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off” see col. 12, lines 1-5);

means for receiving from user equipment communicating with the current active network an indication of a preferred other network (“a mobile subscriber unit sends a code” see col. 16, lines 21-46); and

wherein said current active communication network signals one or more of the plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network (“the current version number is broadcast over the FOCC” see col. 16, lines 21-46).

But, Lynch does not particularly show said second list including at least one network identifier corresponding to a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used (“forbidden” see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to “control the intelligent roaming function” of the user equipment since the intelligent roaming is “a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in” (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch and Daly do not particularly show means for supplying neighboring cell information for the preferred other network based on the indication. However in analogous art, I teaches means for supplying neighboring cell information for the preferred other network based on the indication (“base stations of cells in its neighbor list... indicate to the base station (e.g., BS1) the interference levels that that mobile

Art Unit: 2644

would generate at neighboring base stations (e.g., BS2)" see col. 7, lines 44-63); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Daly as taught by I for purpose of providing the future cell information which would helps the handoff process more reliable and efficient.

The above combination does not specifically disclose the plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area.

In an analogous art, Falco discloses a plurality of available networks are determined by the current active communication network by scanning an area for all available networks within the area (fig. 3 and 6 and particularly col. 6, line 59 to col. 7, line 3 and col. 7, lines 19-52, " Upon receipt of the resulting signals, at step S220, the serving base station 10 determines which neighboring base stations are good candidates for a geo-location of the mobile 40. The neighboring base stations that received the transmit signals from the mobile 40 with a signal quality that is sufficiently high are assigned to be candidate base stations 20," note that the serving base station is equivalent to the "current active communication network," and the candidate neighboring base stations are equivalent to the "available networks." Further note that current base station determines the candidate base stations based on signals received from them and their TOA information, thus, the current base station must scan them as well).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the above combination by having the plurality of available networks to be determined by the current active communication network by scanning an area for all available networks within the area so that the available networks are selected an entity already involved in the communication in the area and thereby providing an efficient communication system.

Referring to claim 46, the combination of Lynch,I and Falco discloses the mobile communications network of claim 32, wherein the serving communication network is provided by a first network provider and at least one of the plurality of available networks is provided by a different network provider (Lynch, "Col. 8, lines 40-41, "hand-off situations," Col. 19, lines 25-43, "download SID list when incoming communication," "after communication has began," Col. 12, lines 2-9, "SIDs available for hand-off," Also see col. 16, lines 21-46 "complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel").

Referring to claim 47, the combination of Lynch,I and Falco discloses the mobile communications network of claim 32, further comprising means for receiving a request, from the user equipment for the first list, wherein the means for transmitting is activated by the request (Lynch, "Col. 8, lines 40-41, "hand-off situations," Col. 19, lines 25-43, "download SID list when incoming communication," "after communication has began," Col. 12, lines 2-9, "SIDs available for hand-off," Also

Art Unit: 2644

see col. 16, lines 21-46 "complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel").

Referring to claim 48, the combination of Lynch, I and Falco discloses the mobile communications network of claim 32, wherein the means for scanning is in a base station (Lynch, "Col. 8, lines 40-41, "hand-off situations," Col. 19, lines 25-43, "download SID list when incoming communication," "after communication has began," Col. 12, lines 2-9, "SIDs available for hand-off," Also see col. 16, lines 21-46 "complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel").

5. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Falco (US 6493539 and further in view of Hicks (US 6,026300).

Referring to claim 39, The combination of Lynch/Falco discloses the method for user equipment for a mobile communication system according to claim 28, and further discloses comparing the received first list with a second list stored in the user equipment (abstract and Col. 16, lines 22-52, "compared to to a preferred SID list").

The combination of Lynch/Falco does not specifically disclose the second list includes at least one network identifier being an identifier of a network that is never to be used.

However, in the same field of endeavor, Hicks teaches this concept (see Col. 3, lines 45-65, " various service providers are classified as either a Home SP, a Partner



Art Unit: 2644

SP, a Favorite SP, a Neutral SP, or a **forbidden SP** based on service provider data stored in the mobile station 16. In general, a list of System ID's (SID) and System Operator Codes (SOC) that correspond to the differing levels of service are stored in the mobile station 16. The service provider SID and/or SOC is broadcast on the control channel. On a DCCH, the SID and possibly an SOC are broadcast. On analog control channels, only the SID is broadcast").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch in the format claimed, for purpose of preventing costly and expensive networks and thus providing a cost efficient handoff.

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch, in view of Falco (US 6493539) and further in view of Johansson (US 6449482).

Referring to claim 40, the combination of Lynch/Falco discloses the method for user equipment for a mobile communication system according to claim 28, further comprising wherein said current active communication network scans an area for all available networks within the area in response to the request (communication network by scanning an area for all available networks within the area (fig. 3 and 6 and particularly col. 6, line 59 to col. 7, line 3 and col. 7, lines 19-52, " Upon receipt of the resulting signals, at step S220, the serving base station 10 determines which neighboring base stations are good candidates for a geo-location of the mobile 40. The neighboring base stations that received the transmit signals from the mobile 40 with a signal quality that is sufficiently high are assigned to be candidate base stations 20," note that the serving base station is

Art Unit: 2644

equivalent to the "current active communication network," and the candidate neighboring base stations are equivalent to the "available networks." Further note that current base station determines the candidate base stations based on signals received from them and their TOA information, thus, the current base station must scan them as well).

The combination is silent on transmitting a request, from the user equipment to the current active communication network for the first list.

Johansson discloses transmitting a request, from the user equipment to the current active communication network for the first list (col. 6, lines 47-67, col. 5, lines 23-55 and Fig. 4, "System information can include and is not limited to information regarding the type and available capacity of the neighboring cell and/or the signal strength measurements made by the requesting mobile station.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination in the format claimed, for purpose of sending neighbor lists only as requested by the requesting terminal and thereby preventing costly and expensive networks and thus providing a cost efficient handoff.

7. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Falco (US 6493539) and further in view of Johansson (US 6449482) and further in view of Rams (US 6,600,925).

Referring to claim 41-42, the combination of Lynch/Falco/Johansson discloses the method for user equipment for a mobile communication system according to claim 28, and further transmitting from the user equipment to the current active

Art Unit: 2644

communication network and receiving, by the user equipment, neighboring cell information (Lynch, col. 12, lines 1-25, Falco, g. 3 and 6 and particularly col. 6, line 59 to col. 7, line 3 and col. 7, lines 19-52, " Upon receipt of the resulting signals, at step S220, the serving base station 10 determines which neighboring base stations are good candidates for a geo-location of the mobile 40. The neighboring base stations that received the transmit signals from the mobile 40 with a signal quality that is sufficiently high are assigned to be candidate base stations 20,")

The above combination does not specifically disclose an indication of at least one preferred other network and receiving, by the user equipment, neighboring cell information for each of the at least one preferred other network based on the indication.

Rams discloses indication of at least one preferred other network and receiving, by the user equipment, neighboring cell information for each of the at least one preferred other network based on the indication (col. 2, lines 15-50, "dual-system mobile station can always be reached in the more favorable network at any given time and can be called there directly by having the mobile station constantly check on whether the subscriber").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination in the format claimed, for purpose of sending neighbor lists only as requested by the requesting terminal and thereby preventing costly and expensive networks and thus providing a cost efficient handoff.

Referring to claim 42, the combination of Lynch/Falco/Johansson/Rams discloses a method for user equipment for a mobile communication system according to

Art Unit: 2644

claim 41, wherein said neighboring cell information includes at least a network frequency and time slot (note that cellular system of Lynch and Falco inherently communicate using either one of the frequency or timeslot channels).

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch further in view of I (US 6,088,335) and further in view of Falco (US 6493539) and further in view of Johansson (US 6449482).

The combination of Lynch/I/Falco discloses the network of claim 32, further comprising means for scanning an area for all available networks within the area (see Falco, fig. 3 and 6 and particularly col. 6, line 59 to col. 7, line 3 and col. 7, lines 19-52, "Upon receipt of the resulting signals, at step S220, the serving base station 10 determines which neighboring base stations are good candidates for a geo-location of the mobile 40. The neighboring base stations that received the transmit signals from the mobile 40 with a signal quality that is sufficiently high are assigned to be candidate base stations 20," note that the serving base station is equivalent to the "current active communication network").

The above combo is silent on means for storing a list of available networks based upon the scanning and corresponding cell information.

Johansson discloses means for storing a list of available networks based upon the scanning and corresponding cell information (col. 6, lines 47-67, col. 5, lines 23-55 and Fig. 4, "System information can include and is not limited to information regarding the type and

Art Unit: 2644

available capacity of the neighboring cell and/or the signal strength measurements made by the requesting mobile station”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination in the format claimed, for purpose of sending neighbor lists only as requested by the requesting terminal and thereby preventing costly and expensive networks and thus providing a cost efficient handoff.

8. Claim 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch further in view of I (US 6,088,335) and further in view of Falco (US 6,493,539) and further in view of Willars (US 7,778,641).

Referring to claim 44, the combinations of Lynch/I/Falco/Johansson disclose the mobile communications network of claim 32.

The combination is silent on wherein the serving communication network is a UMTS network and at least one of the pluralities of available networks is a GSM network.

Willards disclose wherein the serving communication network is a UMTS network and at least one of the pluralities of available networks is a GSM network (Fig. 1, 3, 7 and col. 4, lines 3-35, and col. 6, lines 26-52, "intersystem handovers between a UMTS system and a GSM or PDC system. This occurs when, for example, a mobile phone in a UMTS service area is handed over to a cell being supported by a GSM or PDC system").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination in the format claimed, for purpose of sending neighbor lists only as requested by the requesting terminal and thereby preventing costly and expensive networks and thus providing a cost efficient handoff.

Referring to claim 45, the combinations of Lynch/I/Falco/Johansson disclose the mobile communications network of claim 32.

The combination is silent on wherein the serving communication network is a UMTS network and at least one of the pluralities of available networks is a GSM network.

Willards disclose wherein the serving communication network is a UMTS network and at least one of the pluralities of available networks is a GSM network (Fig. 1, 3, 7 and col. 4, lines 3-35, and col. 6, lines 26-52, "intersystem handovers between a UMTS system and a GSM or PDC system. This occurs when, for example, a mobile phone in a UMTS service area is handed over to a cell being supported by a GSM or PDC system").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination in the format claimed, for purpose of sending neighbor lists only as requested by the requesting terminal and thereby preventing costly and expensive networks and thus providing a cost efficient handoff.

***Response to Arguments***

9. Applicant's arguments submitted on 10/07/2011 have been considered but they are moot in view of new grounds of rejection.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED CASCA whose telephone number is (571)272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard, can be reached at (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred A. Casca/

Examiner, Art Unit 2617

/Patrick N. Edouard/

Supervisory Patent Examiner, Art Unit 2644